

REMARKS

Claims 1-20 are pending in the instant application and stand rejected. Claims 1-3, 11, 19 and 20 have been amended and new Claims 21-~~26~~²⁹ are being submitted for consideration by the Examiner.

Applicants respectfully submit that the instant Amendment overcomes the rejections under 35 U.S.C. 101 and 112. Applicants request withdrawal of these rejections.

The rejection of Claim 1 under 35 U.S.C. 102(b) and Claims 1 and 19 under 35 U.S.C. 103(a) as being unpatentable over JP 54-33542, is respectfully traversed.

JP '542 discloses a grease having additives such as gilsonite and polyolefin hydrocarbons. Examples of polyolefin hydrocarbons include polyisobutylene, polypropylene, polybutene, polyesters. Inert siliceous fillers and oil-soluble antirust agents may be added to the grease. In contrast, the claimed composition comprises a tape, sheet or film. A skilled person in this art would not equate a grease, which lacks any defined three dimensional quality, to a tape, sheet or film.

Moreover, JP '542 fails to disclose a composition comprising polyisobutylene and at least one resin. JP '542 discloses polyolefin hydrocarbons such as polyisobutylene but lacks the addition of at least one resin to the polyisobutylene (as well as the remaining components of the inventive composition). Applicants, therefore, respectfully submit that JP '542 cannot anticipate or establish a prima facie case of obviousness and request withdrawal of this rejection.

The rejection of Claims 5, 9 and 12 under 35 U.S.C. 103(a) as being unpatentable over JP 54-33542 and further in view of Heimann et al (USPN 6,017,857) and Nee (USPN 4,983,449), is respectfully traversed.

JP '542 contains the aforementioned deficiencies. Similar to JP '542, Heimann is directed to a corrosion resistant lubricant, grease or gel; not a tape, sheet or film. Further the silicates of Heimann are not limited to the inert siliceous fillers of JP '542. That is, the silicates of Heimann can impart increased pH or buffering qualities and, therefore, are not inert as required by JP '542 (e.g., compare Col. 3, Line 62-Col. 4, Line 2 of Heimann to the inert siliceous fillers of JP '542). As a result, a skilled person in this art would not employ the silicates of Heimann in JP '542.

Nee discloses a protective wrapping material. A skilled person in this art would not equate JP '542's grease to Nee's tape. That is, a grease is applied in a manner distinct from a tape, has no independent configuration, distinct composition, among other functional and chemical differences. Note also that Nee is concerned with the electrical conductivity of his wrapping material and

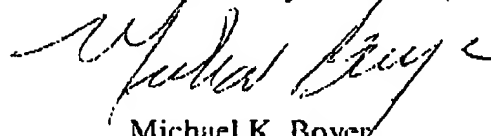
requires porosity to achieve adequate cathodic protection, e.g., refer to Col 3, Lines 1-5, Col. 4, Lines 59-63, and Col. 6, Lines 30-35 of Nee). The grease of JP '542 lacks any disclosure relating to porosity or conductivity. Converting Nee to a grease or JP '542 to a tape would destroy the respective physical characteristics of the products disclosed in these references (i.e., the presence or absence of a defined three-dimensional structure is mutually exclusive). Consequently a skilled person in this art would not consider Nee as being analogous art to JP '542. Assuming *arguendo* that Nee and JP '542 are analogous art, Nee relates to protecting a buried metallic pipe (e.g., Col. 1, Lines 1-10 of Nee) whereas JP '542 teaches treating constructions exposed to direct sunlight. Such different applications would cause a skilled person in this art to lack the requisite motivation to combine JP '542 and Nee. Accordingly, Applicants respectfully submit that JP '542, Heimann and Nee cannot be combined to establish a *prima facie* case of obviousness and, therefore, request withdrawal of this rejection.

The rejection of Claims 2-4, 6-8, 10, 11, 13-18 and 20 as being unpatentable over JP 54-33542, Lyons Jr. (USPN 5,263,287), Heimann et al. (USPN 6,017,857), Nee (USPN 4,983,449), Pacht et al (USPN 6,174,832) and Glorieux (USPN-5,399,189), is respectfully traversed.

Pacht et al. is commonly assigned to the instant assignee, namely, to DeNovus LLC. Pacht et al. also names Donald Taylor, one of the instant inventors, as an inventor. Applicant, therefore, respectfully submits that Pacht is unavailable as prior art and, accordingly, a rejection including Pacht is improper.

Applicants believe that the pending claims define patentable subject matter and respectfully request issuance of a Notice of Allowability. Should there be any fee due in connection with this application, please charge the same to Deposit Account No. 15-0680 (ORSCHILN MANAGEMENT CO.). Should the Examiner deem that any further action on the part of Applicants would advance prosecution, the Examiner is invited to telephone Applicants' attorney.

Respectfully Submitted,



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MARKED UP VERSION SHOWING CHANGES MADE

Please amend Claims 1-3, 11, 19 and 20 as follows:

1(Amended). A composition comprising a combination comprising at least one polyisobutylene polymer, at least one resin, gilsonite, and at least one filler wherein said composition comprises at least one member selected from the group consisting of a tape, sheet and film.

2(Amended). A tape, sheet or film composition comprising a combination comprising at least one [member] polymer selected from the group of [ethylene acrylics] ethylene acrylic copolymers, fluoropolymers, ethylene functional polymers, grafted EPDM, EPDM functional polymers, styrene block copolymers[,] and nitrile functional rubbers[,] ; at least one bitumin, and at least one passivating agent.

3(Amended). A high temperature resistant tape, sheet, film or wrap composition for a metallic pipe comprising a combination comprising at least one polymer, gilsonite, and at least one silicate.

11(Amended). The composition of Claim 10 further comprising [ethyl vinyl acetate] ethylene vinyl acetate.

19(Amended). [Use of] A method for protecting a metallic pipe comprising wrapping the composition of Claim 1 [as a pipeline protectant] around the exterior surface of the pipe.

20(Amended). [Use of] A method for sealing a area defined by automotive components comprising applying the composition of Claim 3 [as an automotive sealant] upon a joint formed between two automotive components.

Please add new Claims 21 through 29 as follows:

- 21. A tape, sheet or film composition comprising a combination comprising at least one polymer selected from the group of ethylene acrylic copolymers, fluoropolymers, ethylene functional polymers, grafted EPDM, EPDM functional polymers, styrene block copolymers and nitrile functional rubbers; at least one bitumin, and at least one passivating agent and wherein said composition is at least partially in contact with a reinforcement defining a plurality of openings and comprising at least one member selected from the group consisting of a scrim, web, matte, mesh, and perforated films

22. The composition of Claim 21 further comprising a removable release film.

23. The composition of Claim 21 wherein said at least one polymer comprises at least one thermosetting polymer and further comprising at least one heat activated curing agent.

24. The composition of Claim 21 said at least one passivating agent comprises at least one silicate.

25. The composition of Claim 23 wherein said at least one heat activated curing agent comprises diacyandiamide.

26. The composition of Claim 24 wherein the silicate comprises calcium silicate.

27. The composition of Claim 24 wherein the silicate comprises sodium silicate.

28. The composition of Claim 26 wherein said bitumen comprises gilsonite.

29. A method for protecting a metallic pipe comprising wrapping the composition of Claim 23 around the exterior surface of the pipe and heating the wrapped pipe to a temperature and for a period of time sufficient to cure the thermosetting polymer.--